UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,488	05/08/2006	Yasuhiro Hidaka	112857-548	1355

29175 7590 07/21/2009	**EXAMINER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/595,488	HIDAKA, YASUHIRO
Office Action Summary	Examiner	Art Unit
	ERIC A. RUST	4146

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 May 2006</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>19-36</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>19-36</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>21 April 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>04/21/2006, 12/19/2006</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

1.   In the preliminary amendment filed April 21, 2006, claims 1-18 were canceled

and claims 19-36 were added. Accordingly, claims 19-36 are pending in this

application.

Priority

2.   Acknowledgment is made of Applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copy of Application No. 2003-365047, filed on October

24, 2003, in the Japanese Patent Office, has been received by the Office.

Information Disclosure Statement

3.   The information disclosure statement filed April 21, 2006 fails to comply with 37

CFR 1.98(a)(3), which requires a concise explanation of the relevance, as it is presently

understood by the individual designated in § 1.56(c) most knowledgeable about the

content of the information, of each patent, publication, or other information listed that is

not in the English language, and a copy of the translation if a written English-language

translation of a non-English-language document, or portion thereof, is within the

possession, custody, or control of, or is readily available to any individual designated in

§ 1.56(c). The IDS has been placed in the application file, but the information referred

to therein has not been considered.

4.   The Examiner notes that claims 19-24 recites "means" which perform certain functions. Claims 19-24, however, are not in the proper format for a 112 6th invocation, and as such, will not be treated under 112 6th.

Specification

5.   Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6.   The abstract of the disclosure is objected to because it contains more than 150 words. See MPEP § 608.01(b). Correction is required.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   Claims 20, 26, and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claims 20, 26, and 32, claim 20, lines 2 and 4 recite "multilevel-image processing." This term is not clearly understood or defined in Applicant's specification. This renders the claim indefinite. Claims 26 and 32, essentially repeat the recitations of claim 20, and therefore are indefinite for the same reasons.

For purposes of examination, the Examiner will interpret the phrase "multilevel-image processing" as meaning any type of image processing performed on an image.

Claim Rejections - 35 USC § 101

9.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-24 and 31-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In regard to claims 19-24, the claims define a "system." However, while the preamble defines a "system", which would typically be indicative of an "apparatus", the body of the claim lacks definite structure indicative of a physical apparatus. Furthermore, the specification indicates that the invention may be embodied as pure software (pg. 14, lines 12-13). Therefore, the claim as a whole appears to be nothing more than a "system" of software elements, thus defining functional descriptive material per se.

Functional descriptive material may be statutory if it resides on a "computer-readable medium or computer-readable memory". The claim(s) indicated above lack structure, and do not define a computer readable medium and are thus non-statutory for that reason. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. The scope of the presently claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program. The examiner suggests:

1.   Amending the claim(s) to embody the program on "computer-readable medium" or equivalent; assuming the specification does NOT define the computer readable medium as a "signal", "carrier wave", or "transmission medium" which are deemed non-statutory; or

2.   Adding structure to the body of the claim that would clearly define a statutory apparatus.

Any amendment to the claim should be commensurate with its corresponding disclosure.

Note:

"A transitory, propagating signal … is not a "process, machine, manufacture, or composition of matter." Those four categories define the explicit scope and reach of

subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be

patentable subject matter." (*In re Nuijten*, 84 USPQ2d 1495 (Fed. Cir. 2007)).

Should the full scope of the claim as properly read in light of the disclosure

encompass non-statutory subject matter such as a "signal", the claim as a whole would

be non-statutory.   Should the applicant's specification define or exemplify the computer

readable medium or memory (or whatever language applicant chooses to recite a

computer readable medium equivalent) as statutory tangible products such as a hard

drive, ROM, RAM, etc, **as well as** a non-statutory entity such as a "signal", "carrier

wave", or "transmission medium", the examiner suggests amending the claim to *include*

the disclosed tangible computer readable storage media, while at the same time

excluding the intangible transitory media such as signals, carrier waves, etc.

In regard to claims 31-36, the claims recite a program that is computer

readable, i.e., a functional descriptive material as evidenced by Applicant's specification

at pg. 14, lines 9-17, which by itself is not one of the statutory subject matters.

However, the claims do not define a "computer-readable storage medium or computer-

readable memory" and is thus non-statutory for that reason. When functional

descriptive material is recorded on some computer-readable medium it becomes

structurally and functionally interrelated to the medium and will be statutory in most

cases since use of technology permits the function of the descriptive material to be

realized.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-36 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent Application Publication No. 2001/0053247 A1 to Sowinski et al. (hereinafter,

Sowinski).

In regard to claim 19, Sowinski discloses a print-ordering system **(Sowinski,**

Fig. 5) comprising:

print-control means **(Sowinski, [0065], line 6, networked computer system)**

which transfers image data to a print system, where the image data is transmitted from

a user terminal via a network **(Sowinski, [0065], lines 1-6)**, and notifies the print

system of image-processing mode of the image data and makes the print system

execute print processing **(Sowinski, [0037], line 40, image printing, and [0071], lines**

1-3, image reproduction that incorporates appearances selected by user, image

reproduction includes printing);

image-processing means **(Sowinski, [0135], lines 2-3, photofinishing service**

provider) which performs image processing for one or more image used for selecting

the image-processing mode (**Sowinski, [0127], lines 1-6, and Fig. 10 item 1004, rendered images are presented to user for selection**);

selection-inquiry means (**Sowinski, [0135], lines 2-3, photofinishing service provider**) that transmits an image-processing-mode-selection image to the user terminal and that receives information about a result of selection made by a user from among the image-processing-mode-selection image (**Sowinski, [0127], lines 1-6, and Fig. 10 item 1004, rendered images are presented to user for selection, according to Fig. 10, user is selecting, among other things, a first choice for image rendering – see category in Fig. 10 above item 1006**); and

selection-result-storing means (**Sowinski, [0129], lines 7-9, since the recitation of storing is given, a selection-result-storing means is inherent**) which stores the selection-result information (**Sowinski, [0129], lines 7-9, stored in file**), wherein the print-control means determines the image-processing mode of which the print system is notified based on the selection-result information stored in the selection-result- storing means (**Sowinski, [0127], lines 1-9, and [0137], line 1 – [0138] line 5, profile is developed from user selection, profile is used to fulfill film processing**).

In regard to claim 25, Sowinski discloses a print-ordering method (**Sowinski, [0002], lines 1-10, the method is inherent**) comprising:

transferring image data to a print system, where the image data is transmitted from a user terminal via a network (**Sowinski, [0065], lines 1-6**), and the print system is notified of image-processing mode of the image data and the print system is made to

execute print processing (**Sowinski, [0037], line 40, image printing, and [0071], lines**

1-3, image reproduction that incorporates appearances selected by user, image

reproduction includes printing);

performing image processing for an image used for selecting the image-

processing mode (**Sowinski, [0127], lines 1-6, and Fig. 10 item 1004, rendered**

images are presented to user for selection);

transmitting an image-processing-mode-selection image to the user terminal and

receiving information about a result of selection made by a user from among the image-

processing-mode-selection image (**Sowinski, [0127], lines 1-6, and Fig. 10 item 1004,**

rendered images are presented to user for selection, according to Fig. 10, user is

selecting, among other things, a first choice for image rendering – see category

in Fig. 10 above item 1006); and

storing the selection-result information in selection-result-storing means

(**Sowinski, [0129], lines 7-9, since the recitation of storing is given, a selection-**

result-storing means is inherent), wherein, the image-processing mode of which the

print system is notified is determined based on the selection-result information stored in

the selection-result-storing means (**Sowinski, [0127], lines 1-9, and [0137], line 1 –**

[0138] line 5, profile is developed from user selection, profile is used to fulfill film

processing).

In regard to claim 31, Sowinski discloses a program that is computer readable

and adapted to control a print-ordering system which produces a print of a print-order

image stored in a user terminal by using a print system (**Sowinski, [0002], lines 1-10,
and [0152], lines 1-4**), the program comprising:

a print-control step adapted to transfer image data to a print system, where the
image data is transmitted from a user terminal via a network (**Sowinski, [0065], lines 1-
6**), and the print system is notified of image-processing mode of the image data and the
print system is made to execute print processing (**Sowinski, [0037], line 40, image
printing, and [0071], lines 1-3, image reproduction that incorporates appearances
selected by user, image reproduction includes printing**);

an image-processing step adapted to perform image processing for an image
used for selecting the image-processing mode (**Sowinski, [0127], lines 1-6, and Fig.
10 item 1004, rendered images are presented to user for selection**);

a selection-inquiry step adapted to transmit the image-processing-mode-
selection image to the user terminal and receive information about a result of selection
made by a user from among the image-processing-mode-selection image (**Sowinski,
[0127], lines 1-6, and Fig. 10 item 1004, rendered images are presented to user for
selection, according to Fig. 10, user is selecting, among other things, a first
choice for image rendering – see category in Fig. 10 above item 1006**); and a

selection-result-storing step adapted to store the selection-result information in
selection-result-storing means (**Sowinski, [0129], lines 7-9, since the recitation of
storing is given, a selection-result-storing means is inherent**), wherein, at the print-
control step, the image-processing mode of which the print system is notified is
determined on the basis of the selection-result information stored in the selection-

result-storing means (**Sowinski, [0127], lines 1-9, and [0137], line 1 – [0138] line 5,
profile is developed from user selection, profile is used to fulfill film processing**).

        In regard to claims 20, 26, and 32, Sowinski discloses wherein the image-

processing means performs multilevel-image processing for the image-processing

mode (**Sowinski, [0126], lines 3-12, multi-level processing includes picture look

preferences**) and the selection-inquiry means transmits at least two image-processing-

mode-selection images obtained by performing a multilevel-image processing to the

user terminal so that the user makes selection (**Sowinski, [0127], lines 1-6, and Fig.

10 item 1004, rendered images are presented to user for selection, according to

Fig. 10, user is selecting, among other things, a first choice through a fourth

choice for image rendering – see category in Fig. 10 above item 1006**).

        In regard to claims 21, 27, and 33, Sowinski discloses wherein the image-

processing means performs the image processing for any one of a sample image stored

in an image database in advance (**Sowinski, [0040], line 6, and [0127], lines 1-6, and

category in Fig. 10 above item 1006**) or the image data transmitted from the user

terminal (**Sowinski, [0135], lines 8-11, the disclosure of presenting one of the

customer's image from a recent order inherently means that the image-

processing means performs the image processing for image data transmitted

from the user terminal. Moreover, Sowinski is directed to photofinishing (see

Sowinski, [0002], lines 1-10), so its inherent that that the image-processing means**

performs the image processing for image data transmitted from the user

terminal).

     In regard to claims 22, 28, and 34, Sowinski discloses means (**Sowinski, Fig.**

4A) adapted to make an inquiry about which of the sample image and the image data of

the user the user wants to select, as the image-processing-mode-selection image, via

the user terminal, wherein the image-processing-mode-selection image is selected and

the image processing is performed according to information about a result of the

selection made by the user for the inquiry (**Sowinski, [0135], lines 8-11, customer's**

image; Sowinski, [0040], line 6, and [0127], lines 1-6, and category in Fig. 10

above item 1006, selection of sample image; Sowinski, Fig. 4A, left column of Fig.

4A under "SELECT LOOKS" heading and "MY PICTURES" heading. The

categories in the left hand column of Fig. 4A are giving the user the option to

select a previous picture ("MY PICTURES"), and a sample image ("SELECT

LOOKS")).

     In regard to claims 23, 29, and 35, Sowinski discloses means (**Sowinski, Fig.**

4A) adapted to ask the user about a type of the image-processing mode in which the

image-processing means performs the image processing via the user terminal

(**Sowinski, Fig. 4A, left column of Fig. 4A, under "SELECT LOOKS" heading**),

wherein the type of the image-processing mode is determined according to a result of

selection made by the user for the inquiry (**Sowinski, [0054], lines 1-21**).

In regard to claims 24, 30, and 36, Sowinski discloses wherein the image-processing mode includes at least one of outline emphasis, hue, color density, gradation, and contrast (**Sowinski, [0126], lines 3-12, hue**).

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure and is as follows:

Greco et al., U.S. Patent Application Publication No. 2002/0120680 A1, teaches providing electronic document services.

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. RUST whose telephone number is (571)-270-3380. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on (571)-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. A. R./

Examiner, Art Unit 4147

07/13/2009

/Anand Bhatnagar/
Primary Examiner, Art Unit 2624
July 18, 2009